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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,374	04/01/2004	Christoph Becke	2001P14043WOUS	9753
46726 7590 11/21/2007 BSH HOME APPLIANCES CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 100 BOSCH BOULEVARD NEW BERN, NC 28562			EXAMINER HANSEN, JAMES ORVILLE	
			ART UNIT .3637	PAPER NUMBER
			MAIL DATE 11/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/816,374

Applicant(s)

BECKE ET AL.

Examiner

James O. Hansen

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-12, 14, 17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-12, 14, 17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-11, 14, 17, 19 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over German publication 9014463 [DE`463] in view of Japanese publication 2001-74359 [JP`359]. DE`463 (figures 1-4) teaches of a storage compartment (fig. 2) for a refrigerator door, the storage compartment comprising: a box shaped body (20) having a first longitudinal wall (24) and a second longitudinal wall (28) and a given depth (now viewed as left to right in fig. 3) extending horizontally between the first and second walls, with a slot (25) extending vertically within the first longitudinal wall at least along a portion thereof; and a compartment divider (30) having a rider (viewed as portion 27 of 22) extending downwardly spaced from a wall thereof located adjacent to the slot for being received within the slot for holding the compartment divider attached within the box shaped body, the compartment divider defining a chamber (fig. 3) for holding small items and extending less than half of the given depth (fig. 3), wherein the compartment divider is defined by four connected walls (fig. 2) which do not extend to a bottom of the box shaped body (fig. 2) to define the chamber within the connected walls for holding items therein, wherein the divider has a height which is less than the height of the body and wherein the slot and rider form a "friction lock" (viewed as a frictional fit) between the rider and walls of the box

shaped body defining the slot as readily apparent to the examiner, in as much as no structural elements are defined. As to claims 19-20, the divider includes a first sidewall (left wall – fig. 3) separated by a first distance from a second sidewall (right wall – fig. 3) and third (left wall – fig. 2) and fourth (right wall – fig. 2) sidewalls between the first and second sidewalls that define a second distance, wherein the rider is connected to the first sidewall and extends downwardly and received in the slot of the body. DE`463 teaches applicant's inventive claimed structure as disclosed above, but does not show the chamber of the divider as having an open bottom or show the divider as having a depth more than half of the given body depth or show the divider as having a depth greater it's width [second distance being less than the first distance]. JP`359 (figures 1-7) is cited as an evidence reference to show that it was known to utilize a divider structure (1) within a box shaped body (2) that defines a storage compartment for a refrigerator door (fig. 2) wherein the divider includes an open bottom (note fig. 4) for allowing items held therein to rest on a bottom of the box shaped bottom. Accordingly, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the divider of DE`463 so as to utilize an open bottom as unequivocally taught by JP`359 because this arrangement would enhance the retaining capacity of DE`463's divider when long items are desired to be held within the chamber since the open bottom would afford additional storage capacity with enhanced holding capabilities of the long items [since the item is now seated within the divider as opposed to being seated upon the divider] in order to safely retain the items as clearly demonstrated by JP`359 [due to pivoting motion exhibited on the items when the refrigerator door is swung open and shut], wherein one of ordinary skill in the art could have substituted one known

element (divider with bottom wall) for another (divider with no bottom wall) since the results of the substitution would have been predictable. As to the specific dimensions of the divider, note the following: the position is taken that it would have been an obvious matter of personal preference to vary the size / shape of the divider and to vary the distance of the divider's outer periphery relative to the body's inner periphery depending upon the needs and/or preferences of the user, since such a modification would have involved a mere change in the size of the divider component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Furthermore, the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). As such, limitations relating to the size of an element are not sufficient to patentably distinguish over the prior art.

3. Claims 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over German publication 9014463 [DE'463] in view of Japanese publication 2001-74359 [JP'359] and further in view of Japanese publication 1-219483 [JP'483]. The combined prior art teaches applicant's inventive claimed storage compartment as claimed by applicant, but does not show third and fourth sidewalls [left and right walls of the divider] of the divider as having a concave shape in the depth direction. JP'483 (figure 6) is cited as an evidence reference to show that it was known to utilize a divider (8) within a box shaped body (7) that defines a storage compartment for a refrigerator (fig. 5), wherein the divider includes a concave shape [inwardly directed] on

opposite sidewalls for the purpose of separating tall items stored on the body [preferably cylindrical items as is conventionally employed in the refrigerator door storage art]. As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the divider of DE'463 so as to incorporate a concave shape on opposite sidewalls in view of JP'483's teaching because this arrangement would provide more stability to items [presumably cylindrical ones i.e., cans or bottles] located on the body and next to the divider since the divider could have a sidewall shape that is complementary to the external shape of an item thereby enhancing the storage capacity of the body while improving the body's capacity to securely retain items while the door is swung between open and closed positions due to the complementary surfaces.

### ***Response to Arguments***

4. Applicant's arguments filed September 20, 2007 have been fully considered but they are not persuasive. With regards to applicant's remarks note the following:

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly, applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of

ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant has submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). After reviewing the rejections made, the position is maintained that a *prima facie* case of obviousness has been established since 1) the Office has demonstrated a finding that the prior art contained a device which differed from the claimed device by the substitution of some element with another element; 2) the Office has demonstrated a finding that the substituted element and its function were known in the art; and 3) the Office has demonstrated a finding that one of ordinary skill in the art could have

substituted one known element for another, and the results of the substitution would have been predictable.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Hansen whose telephone number is 571-272-6866. The examiner can be reached on Monday-Friday between 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



James O. Hansen  
Primary Examiner  
Art Unit 3637

JOH  
November 15, 2007